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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/041,236 03/11/98 LUO

Y EX98-001

EXAMINER

HM12/0118

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LEE, L

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

01/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/041,236

Applicant(s)

Luo et al

Examiner

Li Lee

Group Art Unit

1645



☒ Responsive to communication(s) filed on Nov 19, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 10-13 and 19-22 is/are pending in the application

Of the above, claim(s) 19-22 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 10-13 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. Applicant's amendment filed on Nov 19, 1999 (Paper Number 9) has been received and entered. Claims 14-18 have been canceled and claims 10-12 have been amended, consequently claims 10-13 and 19-22 are pending in the instant application.
2. The rejection of claims 10-13 under 35 U.S.C. 112, first paragraph, because the specification, as being enabling for a polypeptide selected from the group consisting of (a), (b), © and (d) of SEQ ID NO:2, does not reasonably provide enablement for multi/shuffled domains polypeptide of SEQ ID NO:2, is withdrawn in view of applicant's amendment.
3. The rejection of claim 11 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of applicant's remarks.
4. A new reference comes to the attention of the examiner which renders unpatentable of claims 10-13. The finality of the Office action mailed on 8/31/99 is hereby withdrawn in view of the new ground of rejection set forth below.

Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ensser et al (GenEmbl Accession No. AF 030698, Submitted 10/21/97) and Sambrook et al (Molecular Cloning CSH, 1989).

Ensser et al disclose a gene encoding the semaphorin L protein, which is 99.7% identical to the DNA sequence SEQ ID NO:1 encoding the claimed polypeptide SEQ ID NO:2. Ensser et al do not expressly teach the isolated polypeptide encoded by the gene. However, Sambrook et al

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teach the standard method for expressing a known DNA gene. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to express and purify the semaphorin L protein encoded by the gene of Ensser et al using the gene expression method of Sambrook et al in order to study the activity of the semaphorin L protein.

Thus, the claimed invention as a whole was clearly *prima facie* obvious.

Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1645 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li Lee, M.D., Ph.D. whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached at (703) 308-3995.

Li Lee, M.D., Ph.D.
January 10, 2000


ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600